

Remarks:

Claims 1-20 are now pending in this application, claims 12-20 have been withdrawn from further consideration by the Examiner as directed to a non-elected invention. Applicant has amended claims 1, 3, 5-8, and 10 to clarify the present invention.

The Examiner rejected claims 1-11 under 35 U.S.C. § 101 as lacking utility. In particular, the Examiner states that "the claimed punching system is not used to punch a workpiece in the claimed configuration and thus lacks utility." However, the present invention, as recited in independent claim 1, relates to a punch and die alignment system.

The patentable utility of the present invention is explicitly recited in the claim. Furthermore, Fig. 2 illustrates an embodiment of the present "in action" as the alignment is being carried out. The paragraph bridging pages 4 and 5 of Applicant's response to the first office action explains that Fig. 2 illustrates dies being aligned and that Fig. 2 does not illustrate a configuration in which a workpiece is being punched.

Significantly, independent claim 1 recites an invention for aligning a punch and die system. The Examiner's comments ignore the utility recited in the claims and address why the invention

does not have another utility. Applicant submits that the present invention, as recited in the claims has patentable utility and that this utility is amply described in the specification and shown in the drawings. Accordingly, Applicant submits that the claims comply with 35 U.S.C. § 101 and respectfully request withdrawal of this rejection.

The Examiner rejected claims 1-11 under 35 U.S.C. § 112, first paragraph. The Examiner states that it is not clear how the punch operates as depicted in Fig. 2 or in the upper die is partially inserted into the die receiving passage of the lower housing. As described above, Fig. 2 illustrates an embodiment of the punch and die alignment system of the present invention in the process of aligning the dies. The specification clearly describes and the drawings illustrate how the present invention operates as an alignment system. The alignment in no way restricts subsequent use of the invention to punch a workpiece once the dies are aligned and properly positioned for punching.

In view of the above, Applicant submits that the specification does describe the present invention in such a way as to enable one skilled in the art to make and/or use the invention. Therefore, Applicant respectfully requests withdrawal of the rejection of claims 1-11 under 35 U.S.C. § 112, first paragraph.

The Examiner rejected claims 1-11 under 35 U.S.C. § 112, second paragraph, as indefinite. Applicant has amended the claims to clarify the present invention. The term "configured" relates to, among other aspects, the shape and position of the die receiving passage making possible the rotation of a die therein.

Applicant submits that all claims comply with 35 U.S.C. § 112, second paragraph, and respectfully requests withdrawal of this rejection.

The Examiner rejected claims 1-3 and 6~~0~~⁷8 under 35 U.S.C. § 102(b) as anticipated by U.S. patent 4,425,829 to Kranik et al. The Examiner also rejected claims 4, 5, 9, and 11 under 35 U.S.C. 103(a) as unpatentable over Kranik et al.

Kranik et al. does not disclose the present invention since, among other things, Kranik et al. does not disclose a system for aligning dies in a punch and die assembly. Along these lines, Kranik et al. does not disclose a housing that permits dies to be inserted therein and rotated to align the die receiving apertures in the dies. Nowhere does Kranik et al. disclose such elements.

Rather, Kranik et al. discloses a device for removing punched slugs using pressurized air in a tube located below the die aperture.

The Examiner states that Kranik et al. may operate as the present invention operates. However, Kranik et al. does not disclose anywhere that alignment is or can be carried out. Along these lines, Kranik et al. does not describe or illustrate that the dies may rotate to align the die apertures.

In view of the above, Kranik et al. does not disclose all elements of the present invention as recited in claims 1-3 and 6-8. Since Kranik et al. does not disclose all elements recited in claims 1-3 and 6-8, the present invention, as recited in claims 1-3 and 6-8, is not properly rejected under 35 U.S.C. § 102(b). For an anticipation rejection under 35 U.S.C. § 102(b) no difference may exist between the claimed invention and the reference disclosure. See *Scripps Clinic and Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q. 841 (C.A.F.C. 1984).

Along these lines, anticipation requires the disclosure, in a cited reference, of each and every recitation, as set forth in the claims. See *Hodosh v. Block Drug Co.*, 229 U.S.P.Q. 182 (Fed. Cir. 1986); *Titanium Metals Corp. v. Banner*, 227 U.S.P.Q. 773 (Fed. Cir. 1985); *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 1 U.S.P.Q.2d 1081 (Fed. Cir. 1986); and *Akzo N.V. v. U.S. International Trade Commissioner*, 1 U.S.P.Q.2d 1081 (Fed. Cir. 1986).

Kranik et al. also does not suggest the present invention since, among other things, Kranik et al. does not suggest a system for aligning dies in a punch and die assembly. Along these lines, Kranik et al. does not suggest a housing that permits dies to be inserted therein and rotated to align the die receiving apertures in the dies. Nowhere does Kranik et al. suggest such elements. Furthermore, Kranik et al. does not suggest that alignment is an issue or any solutions to alignment.

The Examiner states that Kranik et al. may operate as the present invention operates. However, Kranik et al. does not suggest anywhere that alignment is or can be carried out. Along these lines, Kranik et al. does not include any suggestion that the dies may rotate to align the die apertures.

In view of the above, Applicant respectfully requests favorable reconsideration of this case and early issuance of the Notice of Allowance.

In the event that the Examiner believes that an interview would serve to facilitate the prosecution of this application, Applicants respectfully urge the Examiner to contact the undersigned at the telephone number listed below.

The undersigned hereby authorizes the Commissioner to charge any insufficient fees or credit any overpayment associated with this communication to deposit account no. 22-0185.

Respectfully submitted,

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